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TO: EXAMINER DONALD W. BRAY FROM: JAMES F. BOYLE

COMPANY: UNITED STATES PATENT AND TRADEMARK OFFICE DATE: FEBRUARY 10, 2003

ART UNIT 3725

FAX NO.: 703-305-3579 PAGES: 6

RE: RESPONSE TO ELECTION REQUIREMENT OPERATOR: RHO

SERIAL NO. 09/756,428

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#6/Election

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Art Unit 3725, at 703-305-3579 on the date indicated below.

Robyn O'Neill
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Date: 2/10/03

2/13/03

W. Hart

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/756,428

Examiner: Bray, W. Donald

Filing Date: January 8, 2001

Art Unit: 3725

Inventor: Johansson, Ola M.

Atty. Docket No. 1174.064

Assignee: J & L Fiber Services, Inc.

Invention: *Deflection Compensating Refiner Plate Segment and Method*

RESPONSE TO ELECTION REQUIREMENT

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

In the Office Action mailed January 9, 2003, the Examiner required election of a single species under 35 U.S.C. § 121 for presence of a generic claim. MPEP § 809.02(a). The Examiner has identified claim 1 as generic and has identified the embodiments illustrated in Figures 12, 13, and 15 as allegedly illustrating different species.

I. Election With Traverse

The election requirement is respectfully traversed because, contrary to the Examiner's implicit assertion, the claims are not directed toward *mutually exclusive* embodiments of the invention. Although the requirement is traversed, in order to meet the requirement to elect a species for examination, the applicant hereby provisionally elects an embodiment disclosed but

not identified by the Examiner, specifically, the embodiment of Figure 12 as modified to include the deflection compensation arrangement of Figures 15 – 18. Claims 1 – 4, 7 – 11, 12 – 14, 16 – 36, and 37 – 64 are directed to this embodiment (with claims 9 – 11 and 37 – 43 being directed toward the deflection compensation arrangement of the embodiment shown in Figures 15 – 18 which is disclosed as being usable with the embodiment of Figure 12). Aspects of the second alleged species, illustrated in Figure 13, are claimed in claims 1 – 8, 12 – 23, and 28 – 36. Each of those claims reads on the alleged species of Figure 13, but only claims 5, 6, and 15 are specific to the embodiment of Figure 13, as opposed to reading on both the embodiment of Figure 12 and the embodiment of Figure 13. Each of the method claims 44 – 64 also reads on the second alleged species, but *none* of those claims are specific to the embodiment of Figure 13. That is, each of the method claims reads on both the embodiment of Figure 12 and the embodiment of Figure 13. Hence, even if the Examiner disagrees with applicant's assertion that the Figure 13 embodiment is not a distinct species, only claims 4, 6, and 15 should be withdrawn from consideration at this time.

II. Argument For Withdrawal of Restriction Requirement

The MPEP states:

"Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species."

MPEP §806.04(f). However, the specification states that the deflection compensating features of one embodiment can be used in conjunction with the deflection compensating features of another embodiment as desired. Hence, the Examiner has failed to identify a disclosed embodiment of the invention.

In fact, the characteristics shown in the embodiments of Figures 12 and 13 are not mutually exclusive, but rather represent variations of a single invention. Both embodiments have inwardly offset regions located adjacent the leading and trailing edges of the plate, and the overall magnitude of the offset, whether more drastic as shown in Figure 12 or less pronounced as shown in Figure 13 is affected by the degree of curvature introduced and the length of the portion of plate that is offset. The specification states at page 30, lines 20 – 21 that “the segment thickness can be selectively reduced or the offset selectively increased” with respect to Figure 12. The offset regions of the leading and trailing edges of each plate therefore vary primarily in degree, and the degree of offset is not a mutually exclusive characteristic of either.

Both embodiments also have an inwardly offset region centrally located on the plate. The centrally offset region, like the offset regions adjacent the edges of the plate, can vary in degree of offset magnitude based on the calculated or measured degree of deflection anticipated at that location during operation of the refiner.

The only characteristic shown in Figure 13 that is not shown in Figure 12 is the presence of two outwardly offset regions flanking the centrally offset region of the refiner plate. However, the fact that a drawing illustrating a particular embodiment of an invention bears a characteristic not seen in a drawing illustrating a different embodiment should not and does not imply that the characteristic is exclusive to the embodiment. This is especially so since the addition of

outwardly offset portions to refiner plates that have inwardly offset portions again only varies the face of the plate in a manner designed to compensate for measured or predicted deflection during refiner operation.

As for the third alleged species shown in Figures 15 – 18, in which the mounting portion opposite the face of the refining plate is adjusted to compensate for the deflection of the plate that occurs during operation of the refiner, the specification clearly states on page 37 that such a deflection compensation arrangement *"can be used alone or in combination with one or more of the other deflection compensating methods discussed above."* The embodiment shown in Figures 15 – 18 can have a face with no offset portions or can have a face with offset portions at the leading and trailing edges, or can have a face with a centrally located offset, or can have a face with outwardly offset portions. Likewise, the embodiments shown in Figures 12 and 13 could have a hollowed portion between the legs of the mounting side of the plate in addition to other deflection compensating portions. Not only is the third preferred embodiment not a species mutually exclusive from the others shown in the drawings, but it is in fact an embodiment featuring a characteristic that is specifically available as an option for the embodiments shown in Figures 12 and 13.

The claims further support the non-exclusivity of the characteristic illustrated in Figures 15 – 18. Claim 7, which reads on the first and second preferred embodiments, requires offset portions on the refining surface of the disk refiner plate. Claim 8 is dependent on claim 7 and claims the structure tenon-mortise structure of the plate mount. Claims 9 – 11 are directly and indirectly dependent on claim 8 and these claims are directed toward the hollowed mounting portion as seen in Figure 15. Since a characteristic of the embodiment shown in Figure 15 is

claimed in combination with characteristics of the embodiments shown in Figures 12 and 13, it is not only wrong to say that they are mutually exclusive, it is exactly the opposite of what the specification and claims reveal.

III. Conclusion

In light of the foregoing, withdrawal of the election requirement and consideration of all claims is believed to be in order, and such actions are respectfully requested. Should the Examiner have any remaining questions which when answered would expedite such action, he is invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

J - F 1972

James F. Boyle
Reg. No. 33,653

Dated: February 9, 2003

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